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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Applicant:			
	Randolph E. Crutchfield	Art Unit:	2833
Serial No.:	09/802,032	Examiner:	Gary F. Paumen
Filed:	March 8, 2001	Conf. No.:	2812
For:	Enabling Components to be Removed Without Hot Swap Circuitry	Docket:	ITL.0534US (P10839)

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RULE 181 PETITION

PETITION TO TECHNOLOGY CENTER DIRECTOR PURSUANT TO M.P.E.P. § 1002.02(c) 3.(a) AND 3.(g)

The final rejection in the above-referenced application is premature. For example, prior art was not cited in the first Office action and the Applicant did not amend the claims or submit an information disclosure statement in response thereto. In the second Office action, claim 1 was rejected for the first time pursuant to 35 U.S.C. § 102. Under present practice, a second action on the merits that introduces a new ground of rejection should not be made final. In the response to the premature final rejection, it was pointed out that the final rejection was improper. Nonetheless, the finality of the second rejection was not withdrawn. As a result, this petition is now brought before the Technology Center Director.

Date of Deposit: August 27, 2004
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Ellen Peacock

FACTS INVOLVED

1. On February 18, 2004, a first Office action was mailed rejecting claims 1 through 30 under 35 U.S.C. § 112 ¶ 1, as failing to comply with the enablement requirement. No other rejections were made in the first Office action. Furthermore, no references were cited at this time.

2. On April 30, 2004, Applicant submitted a Reply to Paper No. 2 (first Office action). No amendments to the claims were made in response to the first Office action.

3. On July 23, 2004, a second Office action was mailed finally rejecting claim 1 pursuant to 35 U.S.C. § 102(b) as being anticipated by Ohgami et al.

4. On August 5, 2004, in reply to the premature final rejection, claims 1, 5, and 10 were amended. Furthermore, a notation was made in the reply that the finality of the rejection was premature.

5. On August 20, 2004, an Advisory Action was mailed. The premature final rejection was not withdrawn and the amendments were not entered.

POINTS TO BE REVIEWED

1. Did the second Office action on the merits include a premature final rejection?

2. Should the amendments submitted on August 5, 2004, be entered?

REQUESTED ACTION

The Technology Center Director is requested to withdraw the finality of the rejection asserted in the second Office action mailed on July 23, 2004, and to enter the amendments to claims 1, 5 and 10.

LEGAL ARGUMENT

The second Office action issued in the above-referenced patent application should not have been made final. Usually, a second or subsequent action on the merits is made final. See M.P.E.P § 706.07(a) Final Rejection, When Proper on Second Action. However, there are exceptions to this practice. One exception is where an examiner "introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." *Id.* Furthermore, "a second or any subsequent action on the merits... **will not** be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement... of any claim not amended by the applicant." *Id.* (Emphasis added).

The facts in this case fall under both exceptions. For example, a rejection based on prior art was not asserted in the first Office action. Furthermore, the Applicant did not amend the claims in response to the first Office action. Thus, any subsequent rejection was not based on art cited in the record or necessitated by amendment to the claims. Additionally, an information disclosure statement has not been filed in this application. Thus, a new ground of rejection could not be based on information submitted in an information disclosure statement. Nonetheless, the Examiner entered a new ground of rejection on newly cited art in the second Office action and made the second Office action final. Specifically, in the second Office action, the Ohgami reference served as the basis of a 102(b) rejection, which was not asserted in the first Office action.

The M.P.E.P. is very clear that a second Office action on the merits will not be made final if it includes a rejection on newly cited art of any claim not amended by the applicant. Claim 1 was not amended until after the assertion of the Ohgami reference. Thus, the second Office action should not have been made final. Accordingly, the finality of the rejection in the second Office action is premature and should be withdrawn.

As the final Office action mailed on July 23, 2004, is clearly premature, the amendments to claims 1, 5, and 10 should be entered. When the finality of a rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered. M.P.E.P. § 706.07(e). As explained above, the finality of the rejection in the second Office action is premature. Thus, the

amendments should be entered as a matter of right. In other words, as the second rejection should not have been made final, the amendments in response thereto should not be categorized as amendments after a final rejection.

FEE

A petition pursuant to Rule 181 does not have a fee expressly provided for in Rule 17. If any fee is required, the Commissioner is authorized to charge the fee or credit any over payment to Deposit Account No. 20-1504(ITL.0534US).

STATEMENT THE PETITION IS TIMELY FILED

The complained about action took place on July 23, 2004, and/or August 20, 2004. This matter has been addressed within two months of the mailing date of the action/notice from which relief is requested.

CONCLUSION

In sum, it is respectfully submitted that a premature final rejection was made in the second action on the merits during prosecution of the above-referenced patent application. Withdrawal of the finality of the rejection is in order, which would lead to the entry of the outstanding amendments.

Respectfully submitted,

Date: August 27, 2004

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